

REMARKS

The Examiner's Office Action has been carefully reviewed. Claims 8-11 are cancelled without prejudice to their later presentation in a continuation or divisional application. These claims are cancelled in order to accelerate allowance of the remaining claims, and not for reasons relating to patentability.

Rejections pursuant to 35 USC §103

The Examiner has rejected claims 5-14 as allegedly obvious over the Margolis patent. Margolis discloses the use of a single retinoid, etreninate, for the treatment of osteoporosis. Applicants respectfully traverse this rejection as it may be held to apply to currently pending claims 5-7 and 12-14.

As stated in the last reply, Margolis makes no suggestion that conditions other than osteoporosis may be such treated by administration of retinoids. Nor does Margolis indicate the nature of etreninate: that is, whether it is a retinoid receptor agonist, antagonist, or reverse agonist. Further, Margolis does not indicate which of the two retinoid receptors, RAR or RXR, etreninate affects, or whether it affects both such receptors.

On page 2 of the July 23, 2001 Office Action the Examiner justifies the rejection of these claims by stating that "the healing of a bone fracture . . . can be done the same way as treating osteoporosis . . . ." Leaving aside the fact that claims 5-7 are directed to other pathologies (and thus could not be rendered obvious by Margolis on this basis), the Examiner has not pointed to any support in Margolis for the quoted proposition. Since a reference must provide motivation for a person of skill in the art to make the claimed invention in order to render the invention obvious, The Examiner must indicate where in Margolis such a proposition exists. Applicants respectfully submit that only in light of the disclosure of the present patent application could such a statement be made. Since a patent

application cannot serve as prior art against itself, such hindsight reconstruction is clearly not a proper ground for rejection of patent claims.

For these reasons, Margolis does not render the invention of the pending claims obvious, and Applicants respectfully request that the Examiner reconsider and withdraw the rejection of these claims pursuant to 35 USC § 103(a).

CONCLUSION

Applicants believe the claims are in condition for allowance, and respectfully request the Examiner to issue a Notice to that effect. While Applicant is submitting this reply within the shortened statutory period and therefore does not believe any extension fee is hereby due, if Applicants are in error in this regard, please use our Deposit Account 01-0885 for the payment of any such fee.

Respectfully submitted,

Date:

10/23/01



Carlos A. Fisher (T2-711)  
Attorney of Record  
ALLERGAN, INC.  
2525 Dupont Drive  
Irvine, CA 92612

Telephone: 714-246-4920  
Facsimile: 714-246-4249